

**REMARKS**

**Summary**

Claims 1-5, 7-9, 11-12 and 14-19 stand in this application. Claims 6, 10 and 13 have been canceled without prejudice. Claims 1 and 14 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

Although Applicant disagrees with the broad grounds of rejection set forth in the Office Action, Applicant has amended claims 1 and 14 in order to facilitate prosecution on the merits. Applicant submits that the amendments merely clarify, either expressly or impliedly, what was already present in the claims.

**35 U.S.C. § 112**

Claims 1, 8, 11 and 14 have been rejected under 35 U.S.C. § 112 for not particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. Applicant respectfully traverses the rejection based on the above amendments. These claims have been amended in accordance with the Office Action, and removal of this rejection is respectfully requested. Applicant further submits that the above amendments are made to overcome a § 112 rejection and are not made to overcome the cited reference. Accordingly, these amendments should not be construed in a limiting manner.

**35 U.S.C. § 103**

At page 3, paragraph 5 of the Office Action claims 1-5, 7-9 and 14-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 7,700,890 B1 to Langley et al. ("Langley"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1-5, 7-9 and 14-19. Therefore claims 1-5, 7-9 and 14-19 define over Langley. For example, claim 1 recites the following language, in relevant part:

automatically configuring said first PVC using a list of probe values sent with test packets to probe for configuration information for said first PVC, and using said configuration information to configure said first PVC, wherein said probe values and said configuration information comprise a virtual channel identifier (VCI) and a virtual path identifier (VPI).

As correctly noted in the Office Action on pages 4, 6, 7 and 11, “Langley does not explicitly teach of probe values sent with test packets.”

According to the Office Action, however, the missing language is obvious since:

**these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited.** The probe values will be sent regardless of the data. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.... (emphasis added).

Applicant respectfully disagrees. The above recited language of claim 1 teaches “automatically configuring said first PVC using a list of probe values sent with test packets to probe for configuration information for said first PVC.” Consequently, claim 1 clearly recites that the probe values and test packets probe for configuration information to automatically configure a first PVC. Accordingly, Applicant respectfully submits that the probe values sent with the test packets are functionally involved in the steps recited in claim 1.

Furthermore, the Office Action alleges on pages 11-12 that “[t]here is no functional limitation pertaining to a test packet...these are merely data bits with no functional limitation.” Again Applicant submits that a functional limitation pertaining to the probe values and test packets is clearly recited in claim 1. The probe values are sent with the test packets for “automatically configuring said first PVC.” Consequently, the

probe values and test packets are functionally involved in the steps recited in claim 1 and this descriptive material does distinguish claim 1 from the prior art. Therefore, Applicant respectfully submits that claim 1 is non-obvious and patentable over Langley.

Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, removal of the obviousness rejection with respect to claim 1 is respectfully requested. Claims 2-5 and 7 also are non-obvious and patentable over Langley at least on the basis of their dependency from claim 1. Applicant, therefore, respectfully requests the removal of the obviousness rejection with respect to these dependent claims.

Claims 8 and 14 recite features similar to those recited in claim 1. Therefore, Applicant respectfully submits that claims 8 and 14 are not obvious and are patentable over Langley for reasons analogous to those presented with respect to claim 1. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claims 8 and 14. Furthermore, Applicant respectfully requests withdrawal of the obviousness rejections with respect to claims 9 and 15-19 that depend from claims 8 and 14 respectively, and therefore contain additional features that further distinguish these claims from Langley.

At page 10, paragraph 6 of the Office Action claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Langley in view of USPN 6,711,137 B1 to Klassen et al. ("Klassen"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the obviousness rejection.

Claim 11 recites features similar to those recited in claim 1. Therefore, Applicant respectfully submits that claim 11 is not obvious and is patentable over Langley for

reasons analogous to those presented with respect to claim 1. Furthermore, Applicant respectfully submits that Klassen fails to disclose the missing language. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claim 11. Furthermore, Applicant respectfully requests withdrawal of the obviousness rejection with respect to claim 12 that depends from claim 11, and therefore contains additional features that further distinguishes this claim from Langley and Klassen.

For at least the reasons given above, claims 1-5, 7-9, 11-12 and 14-19 are non-obvious and represent patentable subject matter in view of the cited references, whether taken alone or in combination. Accordingly, removal of the obviousness rejection with respect to claims 1-5, 7-9, 11-12 and 14-19 is respectfully requested. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

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Response Dated November 28, 2006  
Reply to Office Action of August 28, 2006

It is believed that claims 1-5, 7-9, 11-12 and 14-19 are in allowable form.  
Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if  
such contact would further the examination of the present patent application.

Respectfully submitted,

KACVINSKY LLC



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John F. Kacvinsky, Reg. No. 40,040  
Under 37 CFR 1.34(a)

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